

REMARKS/ARGUMENTS

This amendment responds to the office action dated December 20, 2006.

The Examiner rejected claims 2-5 under 35 U.S.C. §103(a) as being obvious in view of the combination of Alexander et al., U.S. Patent No. 6,177,931 (hereinafter Alexander) and Ivanyi, U.S. Patent No. 6,286,140. As amended, independent claim 2, from which claims 3-5 respectively depends, includes the limitation of “a receptacle for receiving a selectively insertable mobile storage device storing a usage preferences description scheme that describes current preferences of a user with respect to said at least one of an audio, an image, or a video comprising a plurality of frames” and “said electronic device is capable of retrieving said usage preferences description scheme from said mobile storage device when inserted into said receptacle and, based upon the retrieved said usage preferences description scheme, automatically identifying selective portions of said content, and wherein said electronic device periodically automatically updates said usage preferences description scheme to be stored on said mobile storage device, based upon said usage history description scheme.” None of the cited references disclose these limitations.

The Examiner contends, with respect to later claims including limitations pertaining to a mobile storage device, that Schnase et al., U.S Patent No. 6,078,928 (hereinafter Schnase) discloses a mobile storage device and that it would be obvious to combine Schnase with Alexander. Though the applicant argues later in this response that such a combination would not be obvious, and incorporates these arguments with respect to the rejection of claim 2, the applicant notes that in any event, Schnase fails to disclose identifying selective portions of content based on preference data stored on the card. (At best, Schnase discloses identifying popular kiosks based upon the number of cards inserted in a kiosk during a time period relative to other kiosks, and/or based on user demographic information stored on the card, which is not preference information.) Nor does Schnase disclose updating information stored on the card based on a user history description scheme.

Finally, as amended, claim 2 includes the limitation of “at least one description type

defined by, at least in part, a thesaurus describing possible user actions including: (i) a user pausing content; (ii) a user fast forwarding content; (iii) a user rewinding content; . . . (vii) a user randomly shuffling content; (viii) a user looping content; and (ix) a user copying from a CD.” None of the cited references disclose this limitation. For each of these reasons, claims 2-5 are patentably distinguished over the cited prior art.

The Examiner rejected claims 6-10 and 43 under 35 U.S.C. § 103(a) as being obvious in view of the combination of Alexander and Del Sesto et al., U.S. Patent No. 6,530,082. The Examiner’s rejection maintains the same rejection set forth in the previous office action, to which the applicant has thoroughly responded. Though the Examiner contends that the applicant’s response was unpersuasive, the Examiner failed to specifically respond to applicant’s arguments, instead simply making the generic assertion (which was also made with respect to applicant’s arguments regarding independent claims 11, 16, 24, and 34, each of which presented different limitations with different arguments as to their patentability) that “the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary, nor is it that the claimed invention must be expressly suggested in any one or all the references, but rather [the relevant issue is what] the combined teachings of the references . . . would have suggested to those of ordinary skill in the art.” The Examiner’s assertion, which may be true in the abstract, continues to be unresponsive to the actual arguments made by the applicant.

The Federal Circuit has unequivocally stated that to “establish a prima facie case of obviousness based upon a combination of the content of various references, there must be some teaching, suggestion, or motivation in the prior art to make the *specific* combination that was made by the applicant.” *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed Cir. 1998)(emphasis added). This requirement of specificity on the part the Examiner to show a prior art motive for the claimed combination “pervades” the legal authority. *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430 (Fed Cir. 2002). *See also Engineered Products Co. v. Donaldson Co., Inc.*, 225 F. Supp.2d 1069, 1120 (N. D. Iowa 2002)(“There must be a teaching or suggestion within the prior art . . . to select particular elements, and to combine them as combined by the

inventor.”).

Of particular relevance, a finding of a prior art motive for a particular combination cannot be supported by a mere conclusory statement by the Examiner as to the benefits of the combination. *See In re Dembiczak*, 175 F. 3d 994, 50 USPQ 2d 1614 (Fed. Cir, 1999).

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved The range of sources available, however, does not diminish the requirement for actual evidence. *That is, a showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence.*

Id., 175 F.3d at 999-1000, 50 USPQ 2d. at 1617 (emphasis added).

The Examiner’s rejection fails to meet this legal standard. Independent claim 6 includes the limitation of “said description scheme including at least one type characterized by, at least in part, a time associated with said at least one of said audio, image, and video, said time expressed in coordinated universal time *and* media time.” (emphasis added). The Examiner concedes that Alexander only discloses expressing a time in media time. The applicant’s argument of record is that there is no prior art suggestion to express the claimed time in *both* media and coordinated universal time. To the contrary, Del Sesto, expressly discloses expressing the time in *either* a coordinated universal time or a local time for broadcast receivers, but not both. Thus, the Examiner’s generic assertions that the *applicant* cannot attack references individually entirely misses the point. The Examiner never made any attempt to explain why one of ordinary skill in the art, upon reading both references, would have modified Alexander’s system to include *both* media and coordinated universal time. This is a threshold obligation *on the part of the Examiner*; the failure to meet it renders the Examiner’s rejection improper.

Furthermore, applicant previously argued that the prior art taught away from the asserted combination, because one of ordinary skill in the art would at best read Del Sesto’s express teaching that either one or the other may be used as a suggestion for a *substitution* rather than an addition. Applicant also noted that the Examiner’s purported motive for the combination – allowing “the system to operate independent of the receivers and transmitters with out the need to

synchronize [those] receivers and transmitters” would be achieved by *substituting* coordinated universal time for media time, therefore *reinforcing* applicant’s arguments; i.e. one of ordinary skill in the art, motivated to achieve the very advantage cited by the Examiner, would not express time in *both* media and coordinated universal time, but would instead take Del Sesto’s suggestion of a substitution. The Examiner failed to respond to this argument, hence the rejection of claims 6-10 and 43 should be withdrawn.

In the same vein, independent claims 11, 16, and 34 each include the limitation of “usage history description scheme stored on a mobile storage device selectively insertable into a multimedia system.” Applicant’s arguments of record were that Alexander, while disclosing the compilation of a usage history description scheme, fails to disclose or suggest storing that scheme on a mobile storage device. The Examiner does not dispute this assertion. The applicant also argued that the secondary reference, Schnase, merely disclosed mobile storage devices (data cards) that could be inserted into display kiosks of museums, zoos, etc to record additional information about the displays for a customer’s later perusal. Though the data cards also store customer profile information, which is readable from the kiosks and from which a museum or zoo may collect demographic information about which displays invoke the most interest, this teaching would be of *no utility* to the system of Alexander. A cable box user has no need to download any content of the cable box onto a magnetic card, nor does either reference disclose the need for Alexander’s profile information to be mobile, given that the profile is only used by a set top box *in the customer’s home*. Absent any prior art disclosure of a need to shop Alexander’s viewer profile information to varying locations, of which the Examiner cites none, then one of ordinary skill in the art would not think to store Alexander’s usage history scheme on a mobile storage device. Moreover, the Examiner’s purported motive, to “provide privacy to users and also programming flexibility” is senseless for the very same reason – Alexander’s profile is only used by a set top box already in the privacy of a customer’s home, and to the extent that the profile information is shared with the service provider so as to push advertising on the customer, privacy is already lost. The Examiner has failed to state exactly how the transfer of profile information from a set top box to a magnetic card would increase the privacy of a customer. Nor has the

Examiner explained how such a transfer would increase programming flexibility not already achieved by Alexander's set top box.

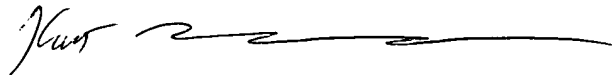
Finally, the Examiner's rejection of claims 24-27 under 35 U.S.C. § 103(a) as being obvious in view of the combination of Alexander and Juels, U.S. Patent App. No. 2002/0026345 was also overcome by applicant's prior arguments. Specifically, independent claim 24, from which claims 25-27 depend, includes the limitation of "said usage history description scheme including data indicating whether personal identification information of said user is intended to be revealed to third parties." Since Alexander neither discloses recording personal identification of any user, nor discloses any need for recording personal identification information (a statement the Examiner apparently does not dispute), then one of ordinary skill in the art would never modify Alexander's system to include an option of whether to reveal or not reveal to a third party that non-existent information. The Examiner's asserted motive of permitting the user to "choose [which] portion of his profile to conceal and provide privacy protections to the user profile information" is irrelevant given that the profile information recorded by Alexander does not include "personal identification information" in the first place. Nor has the Examiner attempted to argue that one of ordinary skill in the art would include personal identification information in a set-top-box-viewer's content profile, such as Alexander's; the content provider has no need to include personal identification information in the profile. Absent some explanation from the Examiner of prior art disclosing the desirability of including personal identification information in Alexander's profile, the Examiner's rejection cannot be maintained. Therefore, each of claims 24-27 is patentably distinguished over the cited prior art and the rejection of each of these claims should be withdrawn.

Amdt. dated March 20, 2007

Reply to Office Action of December 20, 2006

In view of the foregoing amendments and remarks, the applicant respectfully requests reconsideration and allowance of claims 2-38, and 42-48.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kurt", followed by a long, horizontal, wavy line that extends to the right.

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